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PATENT

Attorney Docket No. 28758/36072

#8

6-20-01

P. 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: Lester F. Lau

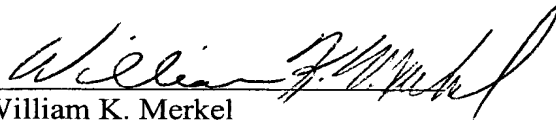
Serial No.: 09/495,448

Filed: January 31, 2000

For: Extracellular Matrix
Signaling Molecules

Group Art Unit: 1643

Examiner: J.T. Woitach

) I hereby certify that this paper and the
) documents referred to as enclosed
) herewith are being deposited with the
) United States Postal Service as First Class
) Mail, postage prepaid, in an envelope
) addressed to: Commissioner for Patents,
) Washington, DC 20231, on this date:
)
) June 11, 2001
)
)
)
) 
) William K. Merkel
) Attorney for Applicant

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In an Office Action mailed May 9, 2001, the Examiner issued a restriction requirement identifying eight claim groups. Applicant requests reconsideration in view of this response. The response is timely filed by the deadline of June 9, 2001, extended to June 11, the next business day. In response to the restriction requirement, Applicant elects claims 4-8 of Group II with traverse.

The Examiner supported the restriction requirement by citing M.P.E.P. §§ 806.04 and 808.01 and stating that the "inventions" are unrelated insofar as the claimed methods "require different materials to practice and different method steps which all result in materially different effects/outcomes." Office Action mailed 5/9/01 at page 3. Applicant

respectfully disagrees that the “inventions” are unrelated. M.P.E.P. § 808.01 states, in pertinent part, that “[t]his situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.” Inspection of claims 1-23 of the instant application reveals that all of the pending claims recite related subject matters. Elected claims 4-8 are drawn to methods of screening for migration modulators using ECM signaling molecule-related biomaterials such as Cyr61. Claims 1-3 and 9-23, categorized in Groups I and III-VIII, are drawn to methods of screening for modulators of a variety of other activities influenced by ECM signaling molecule-related biomaterials such as Cyr61, as well as cells harboring mutations in a gene encoding Cyr61. Thus, the unifying characteristic of pending claims 1-23 is the involvement of an ECM signaling molecule-related biomaterial such as Cyr61.

In addition to citing M.P.E.P. § 808.01, the Examiner relied on M.P.E.P. § 806.04 which provides, in subsection (A), that two different combinations may be independent “inventions,” and providing the method-related example of painting a house and boring a well. The subject matters of pending claims 1-23, relating to ECM signaling molecule-related biomaterials, are not analogous to claiming methods of painting a house and boring a well. As noted above, the unifying characteristic of all of the pending claims is the involvement of ECM signaling molecule-related biomaterials and that unifying characteristic is not reconcilable with a restriction requirement predicated on M.P.E.P. § 806.04, or on the rarely presented circumstances addressed by M.P.E.P. § 808.01.

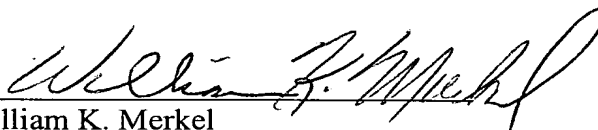
For the foregoing reasons, Applicant submits that the restriction requirement imposed in the Office Action mailed May 9, 2001, is not supported by the facts of the present application and may properly be withdrawn.

Applicant submits that no fee is due in this matter under 37 C.F.R. §1.97(b).
However, if it is determined that any appropriate fee is due, please charge Deposit Account
No. 13-2855. A duplicate of this paper is enclosed.

Respectfully submitted,

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By:


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Reg. No.: 40,725

June 11, 2001